

REMARKS

Claims 1-3 and 5-8 have been amended. No new matter has been added as a result of the above-described amendments. The rejections set forth in the Office Action have been overcome by amendment or are traversed by argument below.

1. Rejection of claims 1-8, 10-11, 43-45, and 56-57 under 35 U.S.C. § 101

The Office Action asserts a rejection of claims 1-8, 10-11, 43-45, and 56-57 under 35 U.S.C. § 101 as allegedly not supported by either a specific and substantial asserted utility or a well established utility.

The Action specifically acknowledges that the credibility of the asserted utility is not disputed, but contends that the asserted utility is not specific or substantial. Applicants respectfully submit that the specification does provide a specific and substantial utility that is supported by the Examples. Specifically, Applicants demonstrate that the GPCR of the invention is highly expressed in white adipose tissue (Example 4 and Figure 5). The Office Action acknowledges (page 3) that those of skill in the art recognize that members of the GPCR family are involved in obesity. Therefore, since the GPCR of the invention was shown to have a high expression pattern in adipose tissue, and those of skill in the art could readily recognize that the GPCR of the invention is useful in treating and/or diagnosing diseases the involve fat metabolism. Applicants specifically ascribe such a use to the GPCR of the invention on page 76, line 14-22. Thus, the specification does provide a specific and substantial use for the GPCR of the invention. Consequently, Applicants respectfully request that the rejection under 35 U.S.C. § 101 be withdrawn.

2. Rejections of claims 1-8, 10-11, 43-45, and 56-57 under 35 U.S.C. § 112, first paragraph

Claims 1-8, 10-11, 43-45, and 56-57 stand rejected under 35 U.S.C. § 112, first paragraph, as allegedly not teaching how to use the claimed polypeptide or nucleic acid molecule based on the alleged lack of utility discussed above. Applicants respectfully contend that a substantial and credible utility has been established, thereby rendering this rejection moot.

Claims 1-8, 10-11, 43-45, and 56-57 also stand rejected under 35 U.S.C. § 112, first

paragraph, as allegedly not being enabled for polypeptides that are at least 70% identical to the polypeptide of SEQ ID NO: 2, polypeptide fragments, or polypeptides having substitutions, insertions, deletions, or truncations that retain the activity of the polypeptide of SEQ ID NO: 2. Without acquiescing as to their previous positions of record (*i.e.* that the specification is enabled for polypeptides that are at least 70% identical to the polypeptide of SEQ ID NO: 2, polypeptide fragments, or polypeptides having substitutions, insertions, deletions, or truncations that retain the activity of the polypeptide of SEQ ID NO: 2), Applicants have amended the claims to recite 95% identical. Applicants respectfully contend that such variation is within the proper scope permitted by the Written Description guidelines (Example 14 of the Written Description Guidelines, available at <http://www.uspto.gov/web/menu/written.pdf>).

The Action also asserts that the claims reciting hybridization conditions lack written description, because they fail to recite functional limitations. The claims have been amended accordingly.

Applicants submit that the claims satisfy the written description requirement of 35 U.S.C. § 112, first paragraph, and respectfully request these grounds of rejection be withdrawn.

3. Priority

The Action indicates that the Examiner has concluded that that subject matter defined in the application is not entitled to the priority dates corresponding to the parent application. The Action asserts that the parent application fails to provide a specific and substantial asserted utility for the claimed invention. As pointed out above, the parent application has the same specific and substantial utility as the present application. The support for the utility is the same as described above.

4. Rejection of claims 1-8, 10-11, 43-45, and 56-57 under 35 U.S.C. § 102

The Office Action asserts a rejection of claims 1-8, 10-11, 43-45, and 56-57 under 35 U.S.C. § 102(a) WO 01/36473, WO 01/36471, WO 01/73029, and WO 01/74904. As discussed above, Applicants respectfully contend that the instant application is entitled to the parent priority date. Thus, claims 1-8, 10-11, 43-45, and 56-57 under 35 U.S.C. § 102(a) cannot be anticipated by any of WO 01/36473, WO 01/36471, WO 01/73029, and WO 01/74904.

Applicants, therefore, respectfully request that this ground of rejection be withdrawn.

5. New Claim rejections

Claims 5-7 are rejected under 35 USC §101 as being directed to non-statutory subject matter. The claims have been amended to recite "isolated" host cell as suggested by the Action. Thus, the rejection has been overcome.

Claim 8 is rejected under 35 USC §112, second paragraph as being indefinite for reciting "GPCR." The claim has been amended to recite the full name corresponding to the acronym, thereby overcoming this rejection.

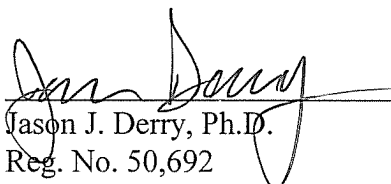
CONCLUSIONS

Applicants respectfully contend that all conditions of patentability are met in the pending claims as amended. Allowance of the claims is thereby respectfully solicited.

The Examiner is invited to contact the undersigned representative by telephone at 312-913-0001 if it is believed to be helpful.

Respectfully submitted,
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